

REMARKS

Applicants thank the Examiner, Mr. Hemant Desai, for courtesies extended during the telephonic interview conducted on June 12, 2007. During the telephonic interview independent claims 1 and 14 were discussed. An agreement was made to amend independent claims 1 and 14 to incorporate the subject matter of dependent claims 9, which amendment would overcome the art of record. No agreement was reached with respect to patentability of the claims. The following comments clarify and expand on the substance of the telephonic interview.

Claims 1, 2, 5, 8, 10-19 are now pending, with claims 1 and 14 being in independent form. Claim 9 has been canceled. Claims 1 and 14 have been amended to incorporate the subject matter of dependent claim 9 which has been canceled. No new matter has been added. Reconsideration of the application, as amended, is respectfully requested.

Claims 1-13 stand rejected under 35 U.S.C. §112, 2nd paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has stated that there is insufficient antecedent basis for the limitation "said at least one further pair of bearings" in line 18. In response to this rejection, Applicants have amended claim 1 in a manner that is believed to address this specific rejection. Withdrawal of the rejection is therefore in order.

Claims 1-2, 8, 9, 18 and 19 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 1,471,755 ("*Schmidt*") in view of U.S. Patent No. 4,811,688 ("*Turner*"). Claim 5 stands rejected under 35 U.S.C. 103(a) as unpatentable over *Schmidt* in view of *Turner*, and further in view of U.S. Patent No. 6,527,029 ("*Ryser*"). Claims 10-13 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Schmidt* in view of *Turner*, and further in view of U.S. Patent No. 5,118,214 ("*Petrzelka*"). Claim 16 stands rejected under 35 U.S.C. §103(a) as

unpatentable over *Schmidt*. Lastly, claims 14, 15 and 17 stand rejected under 35 U.S.C. §102(b) as anticipated by *Schmidt*. For the following reasons, Applicants respectfully assert that all claims of the present application are patentable over the cited reference.

Independent claim 1 has been amended to recite the limitation “said folding-blade shaft having at least two folding-blade carriers for holding folding blades which are spaced apart from one another in a region proximate said carrier by a distance smaller than 10 millimeters” which was formerly recited in dependent claim 9 (now canceled). Independent claim 14 has also been amended to incorporate the subject matter of canceled claim 9, i.e., “folding blades being spaced apart from one another in a region proximate said carrier by a distance smaller than 10 millimeters”. No new matter has been added.

Schmidt discloses a folding mechanism that includes means for effecting a relative change between the sheet path and the folding mechanism as the speed at which the sheets advance may vary. As a result, successive sheets become folded at the same point, such as on a transverse central line, irrespective of their speeds (see pg. 1, col. 1, lines 35-42).

The Examiner (pg. 4) of the Office Action concedes that:

Schmidt does not disclose expressly that the folding blades are spaced apart from one another by a distance smaller than 10 millimeters.

However, the Examiner then asserts that:

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to space folding blades apart by 10 millimeters because *Applicant has not disclosed that by providing 10 millimeters of space between folding blades provides an advantage, is used for any particular purpose, or solves a stated problem.* (Emphasis Added)

Applicants respectfully disagree with the Examiner’s assertion.

As described at paragraph [0008] of the specification as originally filed, “[i]t is possible to reduce the weight of the entire folding device, preferably the folding drum and/or the folding-blade shaft with the folding-blade carrier, as a result of the at least one further bearing point arranged between the bearings at the two ends, as the forces resulting from the rotation are distributed over at least three bearing points”.

As further described at paragraph [0011] of the specification, “[i]t is significant that the carrier for accommodating the at least one additional bearing in the central region of the folding-blade shaft is firstly configured with a small material thickness in the longitudinal direction of the folding device and ... secondly, however, the carrier is configured with a large area which extends over approximately the entire cross section of the interior of the folding drum in the transverse direction of the folding device, in such a way that the stability and torsional rigidity are ensured despite the small material thickness”. These features of the carrier, i.e., “a small material thickness in the longitudinal direction of the folding device” and “a large area which extends over approximately the entire cross section of the interior of the folding drum”, are recited in independent claim 1.

An advantage associated with a small material thickness in the longitudinal direction of the folding device is described at paragraph [0012] of the originally filed specification, i.e., “it is possible to arrange the folding blades very close to one another in the region of the carrier, the gap between the folding blades preferably being smaller than 10 millimeters”. Thus, contrary to the Examiner’s assertion in the Office Action, the specification clearly provides a reason for providing blades close together, since such a configuration would permit the creation of a carrier having a small material thickness that would accommodate the at least one additional bearing of the folding-blade shaft pursuant to reducing the weight of the entire claimed folding device. On

the other hand, Schmidt is clearly not concerned with reducing weight since a shaft 38 runs through the entire folding drum.

It is thus clear that the specification discloses advantages associated with folding blades that are spaced apart from one another in a region proximate said carrier by a distance smaller than 10 millimeters recited in amended claims 1 and 14 that is more than merely a design choice. *Schmidt* fails to teach or suggest folding blades that are arranged in the manner as now recited in amended independent claims 1 and 14. Therefore, independent claims 1 and 14 are patentable over *Schmidt* for this reason.

The Examiner cites *Turner* in an attempt to cure the shortcomings of *Schmidt*, i.e., self-aligning roller bearings, as recited in independent claim 1. The Examiner cites *Ryser* in an attempt to cure the shortcomings of the combination of *Schmidt* and *Turner*, i.e., a central lubrication system for lubricating bearings, as recited in dependent claim 5. *Petrzelka* has been cited in an attempt to cure the shortcomings of the combination of *Schmidt* and *Turner*, i.e., a drive pinion connected to the folding shaft with a “form-fitting connection”. However, each of these references fails to cure the deficiency of the device disclosed in *Schmidt*, because *Turner*, *Ryser* and/or *Petrzelka*, individually or in combination, fail to teach or suggest “folding blades that are spaced apart from one another in a region proximate said carrier by a distance smaller than 10 millimeters,” as recited in amended claims 1 and 14. Therefore, independent claims 1 and 14 are patentable over the combination of the cited art.

Reconsideration and withdrawal of all the rejections under 35 U.S.C. §102(b) and §103(a) are therefore in order, and a notice to that effect is respectfully requested.

In view of the patentability of independent claims 1 and 14, dependent claims 2, 5, 8, 10-13 and 15-18 are also patentable over the prior art for the reasons set forth above, as well as for the additional recitations contained therein.

Based on the foregoing amendments and remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested.

Respectfully submitted,
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